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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 11

Application Number: 09/292,444
Filing Date: April 15, 1999
Appellant(s): BATES ET AL.

Joan Pennington
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/13/03.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims [1-2, 6, 14], [3, 12, and 16], [4, 5, 7, 8, and 9], and [10, 13, and 17] stand or fall together and provide reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,781,914	Stork et al.	7-1998
5,809,317	Kogan et al.	9-1998

"Microsoft Word Tutorial, "Microsoft Word Basic Features."

http://baycongroup.com/wlesson0.htm, Microsoft Word 1997.

Advanced Microsoft Word, "Footnotes and Endnotes"

http://www.utexas.edu/cc/training/handouts/wordadv/

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 6, 10, 12-14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stork et al., US Patent 5,781,914, 7/1998 and further in view of Kogan et al., US Patent 5,809,317, 9/1998.

In reference to claims 1 and 17, Stork discloses a method in which an electronic document can be converted into a hardcopy document from a hypertext document while encoding hypertext link information (compare to ***"computer-implemented method for identifying hypertext links in document printouts"***). See column 1, lines 5-10. The hypertext document is scanned to identify links (compare to ***"scanning a document to be printed and identifying local hypertext links within the document"***). See column 9, lines 9-10. Stork teaches that the encoded information includes location information such as the line number in order to identify the area of the hyperlink (compare to ***"computing and storing a page location of each identified local***

hypertext link within the document"). See column 5, lines 1-30. Stork does not disclose a method for checking printable objects to identify hypertext anchor tags; however, Kogan teaches the creation and maintenance of hypertext links among documents through the use of anchors. See abstract. Kogan teaches using database management technology to relate anchors to links and links to anchors. See column 5, lines 20-30. See also figures 6-8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Stork's method of identifying hypertext links in the hypertext document for conversion into a hardcopy document (capable of being printout) with Kogan's method of checking objects for hypertext anchor tags with a related link since it enables the identification of hypertext links within a document as well as its location. Both Stork and Kogan are of analogous art. Amended claim 1 now cites, ***rendering each printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link.*** Stork teaches encoding the links with the actual path information. See column 5, lines 25-30. Since the path information was encoded with the link, it would have been obvious to display that path information (which is a URL) while rendering the printable objects for any type of link.

In reference to claim 2 and 6, both Stork and Kogan disclose that a hypertext link can be linked to information within the document or an external document. See Stork, column 4, lines 39-41 and Kogan, column 1, lines 46-50. Stork teaches encoding the links with the actual path information. See column 5, lines 25-30. Since the path

information was encoded with the link, it would have been obvious to display that path information (which is a URL) while rendering the printable objects.

In reference to claim 3, Stork discloses identifying the location of the hypertext link by line number. See column 5, lines 5-25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print out a hardcopy identifying the page number for an internal link since it was well known in the art to identify the location of the related hyperlink region with a line number.

In reference to claim 10, Stork discloses identifying hypertext links in document printouts in which the data is stored in memory. See figure 3. Stork also discloses an option to print the hardcopy document. See columns 1-2. Stork does not disclose a predefined indication of each hypertext link; however Kogan does. Kogan teaches using database management technology to relate anchors to links and links to anchors. The rest of claim 10 is rejected under the same rationale used to reject claim 1 above.

In reference to claim 12, Stork discloses identifying the location of the hypertext link by line number. See column 5, lines 5-25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print out a hardcopy identifying the page number for an internal link since it was well known in the art to identify the location of the related hyperlink region with a line number.

In reference to claim 13, Kogan discloses a system consisting of a storage device such as magnetic disk or optical disk. See column 6, lines 15-49. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a computer program product consisting of recording mediums to carry out the

means for checking printable objects. The rest of claim 13 is rejected under the same rationale used to reject claim 1 above.

Claim 14 is rejected under the same rationale used to reject claim 3 above.

Claim 16 is rejected under the same rationale used to reject claim 3 above.

Claims 4, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stork et al., US Patent 5,781,914, 7/1998 and Kogan et al., US Patent 5,809,317, 9/1998 as applied to claim 1 above and further in view of Microsoft Word Tutorial, "Microsoft Word Basic Features". http://baycongroup.com/wlesson0.htm, Microsoft Word 1997.

In reference to claims 4, 5, and 8, it was notoriously well known in the art at the time the invention was made to modify text to be displayed in various formats such as superscript form or bold form. See Microsoft Word Tutorial, pages 3-4. It would have been obvious to one of ordinary skill in the art of document display to modify the printable text of Stork to be represented in bold or superscript form.

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stork et al., US Patent 5,781,914, 7/1998 and Kogan et al., US Patent 5,809,317, 9/1998 as applied to claim 1 above and further in view of Advanced Microsoft Word, "Footnotes and Endnotes" http://www.utexas.edu/cc/training/handouts/wordadv/

In reference to claim 9, it was notoriously well-known in the art at the time the invention was made to display text in footnote form. See Advanced Microsoft Word, pages 3-7. It would have been obvious to one of ordinary skill in the art of document display to modify the printable text of Stork to be represented in footnote form.

In reference to claim 7, Stork discloses encoding information consisting of actual path information (URL). See column 5, lines 25-30. It would have been obvious to one of ordinary skill in the art at the time the invention was made to display the URL for an external link since it was common to identify the path in a hyperlink. it was notoriously well-known in the art at the time the invention was made to display text in footnote form. See Advanced Microsoft Word, pages 3-7. It would have been obvious to one of ordinary skill in the art of document display to modify the printable text of Stork to be represented in footnote form.

(11) Response to Argument

A. In response to appellant's argument regarding claims 1-3, 6, 12, 14 and 16, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Stork teaches detecting hyperlinks in a hypertext document, encoding the location and hyperlink information, and formatting the encoded information into one or more pages and printing a hardcopy version containing the encoded information. See figure 5. Kogan teaches a means for establishing endpoints of anchors for the creation and maintenance of information about relations between regions of documents. Kogan further teaches that there is a need in the art to establish

and maintain associations between documents as a means to link objects at a region in the document. See abstract, and columns 1-2, "Motivation for the Present Invention". The anchors (endpoints of hyperlinks) allow these relationships to be established. Since Stork teaches a means for printing location and hyperlink information and Kogan teaches a means for establishing regions in the document via hyperlinks, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Stork's system of printing hyperlink information with Kogan's method of identifying within anchors, the printable objects.

Moreover, as claimed, Appellant cites, "identifying local hypertext links". Stork's system identifies these links via a barcode.

Appellant argues that the cited Stork and Kogan references provide no suggestion or any means for checking printable objects to identify each printable object within a hypertext anchor tag including printing a corresponding URL for each external hypertext link. However, Kogan teaches using database management technology to relate anchors to links and links to anchors. See column 5, lines 20-30. See also figures 6-8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Stork's method of identifying hypertext links in the hypertext document for conversion into a hardcopy document (capable of being printout) with Kogan's method of checking objects for hypertext anchor tags with a related link since it enables the identification of hypertext links within a document as well as its location. In reference to "including printing a corresponding uniform resource locator (URL) for each external hypertext link", Stork teaches encoding the links with the

actual path information. See column 5, lines 25-30. Since the path information was encoded with the link, it would have been obvious to display that path information (which is a URL) while rendering the printable objects for any type of link.

Regarding claim 10, Appellant argues that the prior art references do not teach a document data or printing program. Examiner maintains that Stork teaches storing the document data in memory in addition to presenting the option for printing the stored document data. See figures 3 and 5, columns 1-2, and the rejections above.

Regarding claim 13, Appellant argues that there is no hint of a computer program product as recited by claim 13 in the references of record. Kogan discloses a system consisting of a storage device such as a magnetic disk or optical disk. See column 6, lines 15-49. It was well known in the art at the time of the invention to utilize recording mediums to carry out the means for checking printable objects as suggest by Kogan since recording mediums were utilized to carry out various computer functions. For the reasons above and reasons stated previously in reference to claim 1, Examiner believes the rejection for claim 13 should be maintained.

For reasons stated in claim 1 above, Examiner maintains rejection for claims 4, 5, 7, 8, 9, and 17.

Regarding claim 4, Appellant argues that the prior art of record does not demonstrate the step of printing said identified page number for a link with the printable object that includes the step of printing said identified page number in superscript form. As Stork teaches, hyperlink location information and other information can be printed. See figure 5. Microsoft Word Tutorial, pages 3-4 illustrate that it was well known in the

art at the time of the invention to represent text in a various formats including superscript or bold form. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to represent the text in a superscript form since the text was already being extracted for presentation.

The combination of Stork and Kogan do teach and suggest the Appellant's claimed invention. Therefore, Appellant's arguments cannot be held persuasive regarding patentability with regard to the claimed invention.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

JOSEPH H. FEILD
PRIMARY EXAMINER

Rachna Singh

March 18, 2003

Conferee

Joseph Feild

Stephen Hong

Rachna Singh